

REMARKS

The Office Action¹ rejected claims 1-5, 8-15, 18-24, and 27-29 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,875,437 to Atkins (*Atkins*) in view of U.S. Patent No. 6,615,240 to Sullivan et al. (*Sullivan*) and U.S. Patent No. 6,470,325 to Leemhuis (*Leemhuis*).

By this Amendment, claims 30-33 are added. Thus, claims 1-5, 8-15, 18-24, and 27-33 are pending in this application.

Applicant respectfully traverses the rejection of claims 1-5, 8-15, 18-24, and 27-29 under 35 U.S.C. § 103(a) as being unpatentable over *Atkins* in view of *Sullivan* and *Leemhuis*. The Office Action has failed to establish a *prima facie* case of obviousness.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *Id.* “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” M.P.E.P. § 2154. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. §2141.02(I), internal citations omitted (emphasis in original).

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. § 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

In this application, a *prima facie* case of obviousness has not been established because the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Office Action has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Claim 1 recites, in part, “providing financial coaching over the wide area network for any projected deficit of income over expenses, said financial coaching including tax advice, business funding advice, spending advice, and investment portfolio balancing advice.” Independent claims 11 and 20, although of different scope, recite similar elements.

The Office Action alleges that *Atkins* teaches “providing financial coaching” as recited in independent claim 1. See Office Action, pgs. 5-6. However, this allegation is incorrect.

Initially, Applicant notes that the Office Action has not specifically identified where the alleged teaching of “providing financial coaching” is found in *Atkins*. Instead, the Office Action generally points to the entire “Summary of the Invention” section of *Atkins* as allegedly teaching the above-identified element, as well as every other element of the claimed invention that is allegedly present in *Atkins*. See Office Action, pgs. 5-7. However, the section of *Atkins* relied upon by the Office Action is silent as to “providing financial coaching over the wide area network for any projected deficit of income over expenses.”

Still further, the remainder of *Atkins* does not teach, nor even suggest “providing financial coaching . . . for any projected deficit of income over expenses.” *Atkins* discloses a method for effecting an improved personal financial analysis through the use of a Home Owner’s Managed Equity Account (HOME Account). See col. 7, line 65 - col. 8, line 5. The HOME Account also allows an individual to choose among a wide variety of mortgage amortization options such that the mortgage holder consistently holds the mortgage at a constant 80% loan to value ratio by ceasing to make amortization payments and instead only paying interest on the loan. See col. 16, lines 16-18; see col. 18, lines 32-34. Thus, funds that might ordinarily be used to amortize a conventional mortgage may instead be invested in various asset accounts in the HOME Account system. See col. 26, lines 35-43.

While users of the HOME Account system can also receive personal financial planning and analysis assistance based on the user's specific investment objectives and budgetary and risk-related constraints, *Atkins* does not teach or suggest projecting a deficit and thus also fails to teach or suggest "providing financial coaching over the wide area network for any projected deficit of income over expenses, said financial coaching including tax advice, business funding advice, spending advice, and investment portfolio balancing advice" as recited in claim 1, and similarly recited in claims 11 and 20.

Sullivan and *Leemhuis* fail to remedy the deficiencies of *Atkins* because they also fail to teach or suggest "providing financial coaching over the wide area network for any projected deficit of income over expenses, said financial coaching including tax advice, business funding advice, spending advice, and investment portfolio balancing advice" as recited in claim 1 and similarly recited in claims 11 and 20.

In view of the above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Accordingly, the Office Action has failed to clearly articulate a reason why the claim would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for independent claims 1, 11, and 20, as well as claims 2-5, 8-10, 12-15, 18, 19, 21-24, and 27-29.

In the event that the Office maintains the rejection of independent claims 1, 11, and 20 under 35 U.S.C. §103, Applicant respectfully requests that the Office, in the interests of compact prosecution, identify on the record and with specificity sufficient to

support a *prima facie* case of obviousness, exactly where in *Atkins* each and every element of the claimed invention is allegedly taught so that Applicant can properly respond to each allegation.

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 18, 2008

By: Ariana Woods
Ariana G. Woods
Reg. No. 58,997